

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application No. : 10/757,221
Appellant(s) : Kaplan et al.
Filed : 1/13/2004
Title : On-Location Electronics Troubleshooting Services System
T.C./A.U. : 3629
Examiner : Matthew L. Brooks
Conf. No. : 3786
Docket No. : P02799
Customer No. : 28548

Mail Stop Appeal Brief – Patents
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REPLY BRIEF

In reply to the Examiner's answer of 5/11/2010, Applicant submits the following remarks for consideration by the Board. Appellant maintains all of its prior arguments as set forth in its Appeal Brief.

ISSUE: Are claims 1-17, and 19-22 patentable under 35 U.S.C. §103 over Morris in view of Springer?

- A) Does Morris teach “notifying automatically” at least one technician, as recited within Claim 1? (Addressing the Examiner's remarks at Examiner's Answer, page 15-18 [paragraphs 27 and 29; see item F below for specific remarks about paragraph 28])

In reply to the Examiner's assertion that Morris discloses "notifying automatically ... at least one technician to provide such on-location electronics troubleshooting services", Applicant respectfully submits that the Examiner is taking quotes from Morris out of context.

CERTIFICATE OF TRANSMISSION

I hereby certify that, on the date shown below, this correspondence is being transmitted to the U.S. Patent and Trademark Office by EFS-Web.

Date: July 9, 2010

/Michael D. Volk Jr./

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In support of his proposition that Morris teaches an automatic notification system, the Examiner quotes from Morris's "Summary of the Invention," at C2, 60-68: "The selection of technician may be handled by either the field service organization or the service center system."

However, this quote has been extracted from the summary rather than from the "Detailed Description," which provides context required to understand the quote. In context, the above quote refers to two alternative embodiments disclosed by Morris: in the first embodiment, a business (known as an "FSO") operates the system; in the alternative embodiment, an independent contractor operates the system on behalf of the business. (Morris, 8:25 to 9:28). In the context of these alternative embodiments, it becomes clear that the independent contractor operating the service center system on behalf of the FSO may select the technician, while the service center system waits for a technician to be identified:

Once the appropriate information is collected into a complete work order, it is ready to be dispatched to a technician. In one mode of operation, work orders are dispatched to technicians by the service center system directly ***on behalf of the office***. In an alternate mode of operation, dispatching of work orders may be handled ***by the office*** ... In modes where the service center system performs the dispatching function, ***the service center system sends the work order to the appropriate technician system as soon as an appropriate technician is identified***. In modes where the office performs the dispatching function, the information for the work order is sent to the office system, **where the office may determine** to which technician to assign the work order.

(Morris, 11:42-63). The Detailed Description did ***not*** state that the service center system automatically notifies a technician; rather, it states that the service center system sends certain information ***"as soon as an appropriate technician is identified."*** Morris discloses a system that is not capable of independently spontaneously notifying a

technician until the technician has been identified for it. Morris' system awaits human instructions ("[T]he information for the work order is sent to the office system, where the office may determine to which technician to assign the work order.") This is NOT an automatic system. "Automatic" is generally defined as:

[H]aving the capability of starting, operating, moving, etc., independently: an automatic sprinkler system; an automatic car wash ... occurring spontaneously: automatic enthusiasm.

Random House Dictionary, © Random House, Inc. 2010. And whereas Morris' system is not capable of spontaneously notifying a technician, it is not an automatic notification system.

Moreover, every reference to Morris cited by the examiner proves Morris uses the term "automated" communications in the same sense as one uses E-mail. Morris refers to electronic communications between humans, not the automatic notification of a human:

- 1) "**information** may be sent between these parties automatically" (Examiner's Answer at Page 15, bottom paragraph quoting Morris at 4:29-35);
- 2) "In this way, the **automated communications** between these systems eliminates the complications, additional steps, and potential failures of **communication** due to requiring the technician to explicitly instruct his system to contact the service center system" (Examiner's Answer at Page 16, first paragraph, quoting Morris at 10:25-34).

Conversely, Applicant teaches and claims a system that independently and spontaneously notifies a technician; Applicant teaches and claims a system for automatically notifying at least one technician. Applicant's specification describes a system wherein management software automatically selects a technician from those technicians assigned to the work cell in which the customer is located; and, the selection is based upon

the elapsed time since last dispatch for each technician. The management software then, *sua sponte*, notifies the appropriate technician. (Spec. 58:17-59:18). Unlike Morris, which waits for a technician to be identified, Applicant teaches a system wherein a computer automatically notifies a technician.

Lastly, Applicant has not "re-defined" the word automatic in its specification. Applicant's stated objective, "automatically dispatching technicians, with little or no human involvement," is not inconsistent with the generally accepted definition of "automatic." Applicant's claimed system independently and spontaneously notifies technicians - - by definition this is an automatic notification. And, like every other automated system created by man, there is always some *de minimis* human involvement. A human is involved in building, installing, maintaining and turning on the system. However, unless taken to *ad absurdum*, "little or no human involvement" is the defining feature of most automatic systems. Applicant has not re-defined "automatic."

B) Does Morris teach "collecting automatically" at least one fee "relating to such on-location electronics troubleshooting services"? (Addressing the Examiner's remarks at Examiner's Answer, page 5, 3rd paragraph to page 6, 1st paragraph)

In reply to the Examiner's assertion that Springer teaches collecting a fee relating to on-location electronics troubleshooting services, respectfully, Springer teaches a system of automatic periodic **pre**-payments for pest control services (Springer, Page 2, Paragraph 23). Springer does not teach a system for automatically paying for services rendered, let alone relating to the automatic collection of fees for an electronics troubleshooting service.

C) Does Morris teach a system that ensures that customers and technicians are sufficiently co-located within geographical areas to provide appropriate response times"? (Addressing the Examiner's remarks at Examiner's Answer, page 18 to page 20 [paragraphs 30-31])

In reply to the Examiner's assertion that Morris teaches the features recited in Claim 2, to wit, a system wherein the customer and technician are "co-located" within geographical areas to provide appropriate response times," respectfully, Morris does not teach geographic co-location.

"Co-locating" the customer and technician within the same geographic areas is defined within the specification as assigning technicians to "work cells" covering clients residing within specific geographic areas. (Spec., 58:17 to 59:8). Conversely, Morris merely teaches that a GPS system is useful for technicians trying to find a client's address. (Morris, 14:53-58). Morris does not teach a system where client and technician are geographically co-located so as to improve response times; rather, Morris teaches that a GPS system can be used to find an address.

Aware that Morris does not teach co-locating the technician and customer, the Examiner relies on his imagination to deduce details through implication that Morris failed to express through specification. Morris teaches:

The service center system sends the work order to the appropriate technician system as soon as an appropriate technician is identified

(Morris, 11:42-63). From this quote, the Examiner concludes that the "appropriate technician" refers to a technician co-located to a customer's geographic area. However, Morris never teaches a criteria or system for identifying an appropriate technician. Respectfully, the Examiner's imagination is not a proper substitute for gaps in the prior art.

D) Does Morris teach "job completion trends"? (Addressing the Examiner's remarks at Examiner's Answer, page 20 [paragraph 32]).

The Examiner has dismissed Appellant's remarks with respect to Claim 3 because the Examiner alleges that a "job completion trend" feature has not been claimed. The opposite is true. Claim 3 positively claims those steps which permit the system to provide a job completion trend feature (i.e., receiving start time of such on-location electronics troubleshooting service, on such at least one Internet website client server, from selected such at least one technician; receiving end time of such on-location electronics troubleshooting services, on such at least one Internet website client server, from selected such at least one technician; etc.). Thus, the issue is not "moot" as the Examiner alleges. Respectfully, Appellant maintains the arguments set forth in the appeal brief which assert, *inter alia*, that a start time and end time are different from "hours worked" in that the start and end time data translates to more accurate estimates of arrival time for the benefit of customers (since a particular technician's job completion history will be measurably available).

E) Does Morris teach a system for selecting a repair service of a selected type? (Addressing the Examiner's remarks at Examiner's Answer, page 7 [paragraph 7] and page 20 [paragraph 33]).

In the Examiner's rejection of Claim 4 the Examiner cites sections of Morris that illustrate that a technician may make notes about a particular problem. For example, in FIGS. 4 and 5, the technician describes the problem that is being experienced ("Boiler not functioning properly"). In FIG. 7b, the technician makes further notes about the problem experienced ("bad bearings", "bad belt", etc.). It is respectfully submitted that making notes about a problem is materially different from Appellant's claimed invention in Claim 4

which relates to, *inter alia*, a feature wherein the technician selects the repair service and the system automatically notifies the appropriate party of the repair need. It is respectfully submitted that the Examiner's evidence regarding the "note-taking ability" feature of Morris does not establish a *prima facie* case of unpatentability for the claimed invention.

F) Applicant's Claim 19 recites matter that the Examiner has dismissed as moot.
(Addressing the Examiner's remarks at Examiner's Answer, page 17 [paragraph 28])

On page 17, paragraph number 28 of the Examiner's answer, the Examiner alleges that Appellant has failed to claim particular details of Appellant's automatic notification feature which considers the time of the last dispatch, the work cell of the technician, and dispatching of a technician who has had the longest time since last dispatch. These details are squarely presented in Appellant's Claim 19 which claims the dispatch selection criteria (identifying at least one of such at least one technician assigned to such same geographic dispatch area as such service location of such at least one customer requesting on-location electronics troubleshooting services, and identifying at least one such technician having greatest elapsed time since such last notification, etc.). Respectfully, neither Morris nor Springer teach or suggest these particular details.

(continued on next page)

In view of the above additional remarks, Appellant respectfully requests that the Board find for the Appellant and asks for a reversal of the Examiner's rejections.

Respectfully submitted,

Date: July 9, 2010

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